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EXAMINER

NEWTON, JARED W

ART UNIT	PAPER NUMBER
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3692

NOTIFICATION DATE	DELIVERY MODE
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09/24/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/057,737	Applicant(s) SWIFT ET AL.	
	Examiner Jared W. Newton	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Final Rejection is in reply to the Amendment filed July 6, 2007, by which:

- Claims 1-9, 11-12, 14, 16-20 and 26-27 were amended;
- Claims 1-30 are pending.

Claim Objections

The Applicant is thanked for correction of the Claim Objections noted in the Office Action mailed April 9, 2007. The Objections are hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the following recitations were not supported by the Specification as originally filed:

- “receiving over a network the check MICR data for a second check drafted by the customer, the second check drafted after the first check...” (claim 1, lines 10-11);

- “receiving a communication indicating that the second check failed to clear...” (claim 1, lines 14-15);
- “locating the first database record using the account number as at least a portion of a first search key when the second check failed to clear...” (claim 1, lines 17-18);
- “a second search key” (claim 5, lines 4-5);
- “a second search key” (claim 6, line 5);
- “a prior check transaction by the customer, the prior check transaction occurring prior to the failed check transaction...” (claim 9, lines 9-10);
- “a prior check drawn on the account by the user prior to the failed check...” (claim 20, lines 8-9).
- “a communication indicating that a second check drawn on an account by a drafter was not honored...” (claim 26, lines 4-5);
- “receiving the communication that the second check was not honored...” (claim 26, line 9);
- “second check...” (claim 28, line 2);
- “second check...” (claim 29, line 2);
- “second check...” (claim 30, line 2);

In particular, the Specification as originally filed does not set forth in sufficient detail so that one of ordinary skill in the art would be able to make and or use the invention, a “second” check, or a check submitted after a “prior” check, wherein a search key is drawn from that check to locate customer information in a database. In the

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remarks filed July 6, 2007, the Applicant did not provide basis for these newly added limitations by reference to the Specification or Drawings. Upon a thorough search of the Specification and Drawings, the Examiner is unable to find sufficient support. For instance, paragraph [0012] mentions only a "first check;" [0013] mentions only a "first transaction;" [0027] mentions only a "check," not a "first" or "second" check; [0032] mentions a determination of "insufficient funds," but does not specify if that determination is made on a "first," "second" or "prior" check; and, [0037], [0038] and [0040] mention only a "first check."

Further, the Specification as originally filed does not set forth in sufficient detail the use of "first" and "second" search keys.

The limitations should be canceled from the claims, or indicated, by reference to page numbers, paragraphs, line numbers and or figures, as supported by the Specification as originally filed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22, and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,679,940 to Templeton et al. (Templeton).

In regard to claims 1, 9, 13, 20, and 21, Templeton discloses an apparatus and method for accepting a check over a communications network, wherein check MICR data is sent over the network (see FIG. 5, steps 205 and 225); the check writer's driver license data is sent over the network (see col. 2, line 54 – col. 3, line 8); the MICR and license data are stored in a database provided by a check acceptance service (see id.); the check is electronically submitted for settlement via a point-of-sale terminal that scans the MICR data (step 205); receiving a communication from the authorization host computer that the check is declined (see col. 30, lines 44-46); locating a database record using the account number as a search identifier (see col. 32, lines 45 – 49); and reading the driver's license data from a database record and transmitting at least a portion of the driver's license data to a recipient such as a merchant (see col. 32, line 45 – col. 33, line 45). Templeton states:

"[O]nce the check acceptance service is able to append a customer's name to the other data maintained in the positive file, the check acceptance service is able to provide the customer's name along with subsequent approval codes ... Name and address information may also be useful to merchants who want to compile of [sic] list of their check writing customers ... prior art systems did not facilitate the collection of such information. However the preferred transaction terminal 15 allows merchants to quickly and efficiently capture name and address information by electronically reading magnetic stripe drivers licenses ... The name and address data will be retained by the authorization host computer if the data is not already included in the check acceptance service's databases." Id.

It is noted that it is inherent that checks are declined due at least in part to insufficient funds.

Templeton further teaches storing check and customer information, including *inter alia*, payment data, identification data, merchant data, product data, MICR data from a check, and identification data from a magnetic stripe on an identification card (see col. 4, lines 59-67). Templeton further discloses a database for storing said data (see e.g. claim 9). Templeton further discloses an initial transaction packet of information sent to a host computer to determine if a check should be declined, and if said check is declined (not cleared), accessing said database for additional information on which a subsequent determination of whether to clear a check is based (see col. 4, lines 20-67). Templeton further discloses the database including data retained from a prior transaction, wherein said data is used to analyze a subsequent transaction (see col. 7, lines 43-65).

Templeton further discloses searching the database for records that match either checking account data or driver's license data (see col. 27, line 60 – col. 28, line 11).

In regard to claims 2 and 12, Templeton discloses drivers' licenses including driver's license numbers (see e.g., col. 2, line 54 – col. 3, line 8).

In regard to claim 3, Templeton discloses driver's license data including a customer's address (see e.g., col. 33, lines 1-3).

In regard to claims 4 and 11, Templeton discloses searching using MICR data (see col. 32, lines 45-49). It is inherent that MICR data includes both an account number and a bank routing number.

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In regard to claim 5, Templeton discloses locating separate database records, for instance, "positive" and "negative" database records (see col. 3, lines 6-16), and transmitting the records to a recipient as set forth above.

In regard to claim 6, Templeton discloses both positive and negative database records being located with account numbers (see e.g. col. 32, lines 45-49).

In regard to claims 7 and 16, Templeton discloses merchant data stored in the check acceptance service's data records, said merchant data used to "determine whether the merchant is an active client, and to identify the services provided to the merchant" and is transmitted to a first recipient (see col. 2, line 67 – col. 3, line 5).

In regard to claims 8 and 10, Templeton further discloses locating a customer using the name and address information obtained from the driver's license data (see col. 32, lines 56-60).

In regard to claim 14, Templeton discloses the check acceptance service, which can guarantee payment (see col. 2, lines 20-26), is also a recipient of information customer data.

In regard to claim 15, Templeton discloses the first transaction record further including the transaction amount (see col. 2, lines 60-67).

In regard to claims 17, 18, and 22, Templeton discloses the use of a paper check and a "data card," including a check card (see col. 10, lines 18-32).

In regard to claim 19, the apparatus and method disclosed by Templeton is for processing an electronic check.

In regard to claim 25, Templeton further discloses account data entered manually at the point-of-sale (see col. 21, lines 1-17).

In regard to claims 26-30, Templeton discloses the apparatus and method as set forth above, and further discloses a computer readable memory executing programs (instructions) for enabling the apparatus and method (see e.g., col. 16, line 61 – col. 17, line 49; col. 27, lines 25-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton as applied to claims 1-22, and 25-30 above, alone.

Templeton discloses the apparatus and method for accepting a check as set forth above, but does not explicitly disclose:

- The check in the form of a check card that includes a bar code that stores the account number.

Templeton discloses the check in the form of a check/debit card as set forth above (see claim 17 rejection). The examiner takes official notice that it is well known that such check and debit cards include bar codes and magnetic strips, each of which

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include account information such as account number, balance, and customer information.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton as applied to claims 1-22, and 25-30 above, and further in view of US Patent No. 6,283,366 to Hills et al. (Hills).

Templeton discloses the apparatus and method for accepting a check as set forth above, but does not disclose:

- A portion of the account information being optically read from the check (claim 24).

Hills discloses a system for reading check information at a point-of-sale, said system comprising including "optical character recognition ("OCR") equipment" (see col. 6, lines 45-63).

The Templeton and Hills references are analogous art because they are from the same field of endeavor—check authorization. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the OCR equipment as disclosed by Hills in the apparatus as disclosed by Templeton. The motivation to do so would have been to provide an additional means of reading check or card information into the system.

Response to Arguments

Applicant's arguments filed July 6, 2007 have been fully considered but they are not persuasive. In particular, the Applicant's Remarks are based on the newly added subject matter set forth above, and the newly added matter has not been considered in view of its rejection under 35 USC § 112, 1st Paragraph. Moreover, the Examiner contends that the Templeton reference anticipates the newly added limitations, as set forth in the 35 USC §102 rejections above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

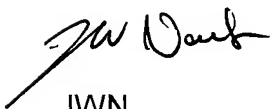
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared W. Newton whose telephone number is (571) 272-2952. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JWN
September 10, 2007



Kambiz Abdi
Supervisor – AU 3692